

Application SN  
09/745,669

### REMARKS

Claims 1-7, 17-24, 28 and 31-32 are now pending in the application.

Claims 8-16, 25-27, 29-30 and 33-41 have been canceled.

Independent Claim 28 has been amended.

Claims 1, 7, 17 and 28 are independent.

### Prior Art Rejections

Claims 1-16 and 25-41 were rejected under 35 USC 102(e) as being anticipated by US Patent 6,587,835 (Treyz) and Claims 17-24 were rejected under 35 USC 103(a) as being unpatentable over Treyz. Of course the cancellation of Claims 8-16, 25-27, 29-30 and 33-41 renders the rejections of those claims moot. Each of these rejections as to the remaining claims is respectfully traversed and reconsideration is requested.

### Section 102(e) Rejection

#### Independent Claims 1 and 7

In the rejection of Claims 1-16 and 25-41 as anticipated by Treyz, the Action takes the position that "Treyz discloses a system in which a handheld computing device may be used to provide a user with shopping assistance services"...and that "if desired the configured to accept any number of other accessories, including CD drives, DVD drives, PC card readers, memory card readers, etc. [Col 15, Line 50]".

Applicants strongly disagree with the alleged "reading" of the teachings of Treyz on Applicant's claimed invention. Specifically, the precisely defined purpose in the manufacture of "handheld computing device 12" of Treyz is "to provide a user with shopping assistance services...to handle shopping lists...to obtain information on products...reminders and other messages may be sent to the handheld computing device...etc" (Abstract).

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The device of Treyz does not teach or suggest, and one of ordinary skill in the art would not anticipate, in light of 'Treyz' teachings, an apparatus such as that recited by Applicant's independent Claims 1<sup>1</sup> and 7<sup>2</sup> of a portable consumer good that lacks the capacity for data transmission.

Col 15, line 50 of Treyz (which the Office Action cites to as describing that "the device can be configured to 'accept' any number of other accessories, including CD drives, DVD drives, PC card readers, memory card readers, etc.") in full paragraph states:

"[I]f desired, a Bluetooth module or other wireless communications circuitry 104 may be added as an accessory or expansion module...[a]n expansion module may be provided that provides video capabilities to handheld computing device 12 (c.g., MPEG-2 or MPEG-4 capabilities)...[i]f handheld computing device is already configured to include such capabilities, an expansion module may be provided that enhances video capabilities of handheld computing device 12...[m]edia drives 102 such as a CD drive, a floppy drive, a PC card reader, a memory card reader, a DVD drive, of any other suitable drives may be added or attached to handheld computing device 12...[o]ther accessories and attachments 106 may be used if desired...[s]uch other accessories and attachments may include, for example, a scanner, a printer, etc." (emphasis added).

Treyz merely mentions the possibility of "adding drives" and "expansion modules" to a handheld computing device 12 that is designed for the actual purpose of assisting users in shopping and in performing wireless transactions - the statement recited above in Treyz that allows for this computing device 12 that a "CD drive", "may be 'added or attached' to the handheld computing device 12, simply does NOT teach or suggest a portable consumer good defined by Applicant's independent Claims 1 and 7, that lacks the capacity for data transmission.

<sup>1</sup> Independent Claim 1 is directed to an apparatus for retrieving information related to a consumer product using a consumer product codes. The apparatus includes a portable consumer good that lacks the capacity for data transmission and a scanning and storage device in mechanical communication with the portable consumer good. The scanning and storage device includes (i) a scanning element converting a product code symbol into machine readable information representative of the product code, and (ii) a removable memory medium to which the information is stored.

<sup>2</sup> Independent Claim 7 also recites that the apparatus includes an Internet-ready device couplable to one or more Internet-based information servers, the Internet-ready device including a removable memory medium adapted to accept the removable memory medium from the scanning and storage device.

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For at least the foregoing reason, Applicant submits that independent Claims 1 and 7 are patentable over Treyz and reconsideration is respectfully requested.

#### Independent Claim 28

Independent Claim 28, as amended herein (to include the limitations of now canceled dependent Claim 30), is directed to a method for retrieving information related to a consumer product comprising the steps of integrating a bar code scanner and a removable memory into a consumer good that is a *non-electronic device*, scanning a bar code of a selected consumer product using the integrated scanner and storing the scanned bar code in the removable memory, and accessing a web site on a computer network based on the scanned bar code, wherein the web site includes information related to the selected consumer product.

Treyz clearly fails to teach or suggest a method such as that recited in amended independent Claim 28 in which a bar code scanner and a removable memory are integrated into a consumer good that is a *non-electronic device*.

For at least the foregoing reason, Applicant submits that each of independent Claim 28 is patentable over Treyz and reconsideration is respectfully requested.

#### Section 103(a) Rejection

#### Independent Claim 17

In the rejection of Claims 17-24 as unpatentable over Treyz, the Action takes the position that while "Treyz does not explicitly disclose aiding the consumer by providing a list of complementary products", "cross-selling is a well-established business principle as a means of increasing a vendor's per-transaction revenue...a list of complementary products in association with a particular item would merely have been another entry in the product information database...it would therefore have been obvious...to include in the produce information database...a list of complementary products".

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Applicant respectfully traverses this rejection, and submits that the rejection relies upon impermissible hindsight in light of Applicant's own application, to arrive at the reasoning set out in the rejection.

Independent Claim 17<sup>3</sup> is directed to a system that includes, among other limitations, a server that has a database with a list of secondary consumer products that are related to each of primary consumer products, and which is adapted to transmit a list of such secondary products that are related to the selected primary consumer product.

Applicant submits that it would *not* be obvious to modify the handheld computing device 12 of Treyz simply based on the allegation in the Office Action that "cross-selling is a well-established business principle".

Of course, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. *Finally, the prior art reference must teach or suggest all the claim limitations.* The teaching or suggestion to make the claimed modification and the reasonable expectation of success *must both be found in the prior art and not based on applicant's disclosure.* *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991), 706.02(j) [emphasis supplied].

Treyz alone fails to render independent Claim 17 unpatentable. Therefore, reconsideration of the rejection based thereon is respectfully requested.

Claims 2-6, 18-24 and 31-32 depend from independent Claim 1, 17 or 28 and recite further limitations that even further distinguish over Treyz.

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<sup>3</sup> Claim 17 is directed to a system for providing information to a user including a scanner converting a printed code of a selected primary consumer product into machine-readable information representative of the code, a computer adapted to receive the machine-readable information from the scanner, a server couplable to the computer, a database couplable to the server and storing information representative of (a) a universal product code for each of a plurality of primary consumer products, and (b) a list of secondary consumer products that are related to each of the plurality of primary consumer products, the server adapted to receive a request for related consumer product information from the computer, the request including information representative of the machine-readable information, and the server adapted to retrieve and transmit the related consumer product information to the computer, the related consumer product information comprising a list of one or more secondary consumer products that are related to the selected primary consumer product.

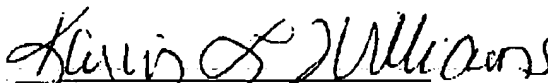
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It is respectfully submitted that remaining pending Claims 1-7, 17-24, 28 and 31-32 are patentable over Treyz.

Request for Telephonic Interview

Should the Examiner maintain the rejection based on Treyz despite Applicant's discussion above, Applicant respectfully requests that the Examiner telephone the Applicant's attorney at (908) 518-7700 in order that any outstanding issues be resolved.

Respectfully submitted,



Karin L. Williams

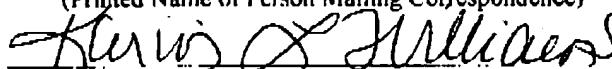
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